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In re application of

RADIGON et al.

Serial No.: 09/341,543

Filed: February 17, 2000

For: PRESSURE SENSITIVE ADHESIVE WHICH CAN BE
APPLIED WHILE HOT

:
: **DECISION ON**
: **PETITION**
:
:

This is a decision on the petition under 37 CFR 1.181 filed September 12, 2001, in Paper No. 14, to review the restriction requirement as set forth in the action mailed January 16, 2001, in Paper No. 11.

BACKGROUND

The present application was filed on the national stage under the provisions of 35 USC 371. In reviewing the propriety of a restriction requirement, i.e. the presence or absence of "Unity of Invention," in such an application it is understood that unity of invention is to be evaluated by the criteria described in PCT Rules 13.1-13.2 or 37 CFR 1.475. According to PCT Rule 13.2:

Where a group of inventions is claimed in an application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

Furthermore, 37 CFR 1.475 (b) or Annex B to the "PCT Administrative Instructions" in Appendix AI of the *MPEP* describes different combinations of categories of inventions that may be held to have unity of invention due to their possession of such a technical relationship.

The examiner imposed a two way restriction under 35 USC 121, relying in part, on the argument that the two Groups of Invention, i.e., Group I directed to a non-reactive pressure sensitive hot-melt adhesive composition, and Group II directed to a pressure sensitive layer produced by applying while molten the non-reactive pressure sensitive hot melt adhesive composition of claim 1 to a substrate, "are related as mutually exclusive species in an intermediate-final product relationship". The examiner further expands his explanation in that "the intermediate product is deemed to be useful as a raw material for extruded sheeting and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious".

Petitioner argues that the application should have been treated under the rules of the PCT, as it is a national stage application of an International application PCT/FR98/02409, and that U.S. national stage applications filed under 35 USC 371 are subject to unity of invention practice in accordance with 37 CFR 1.475 and 1.499. The petitioner, then goes on to set forth examples 15, 12 and 13 found in Annex B to

the "PCT Administrative Instructions" in Appendix AI of the *MPEP*.

DECISION

Unity of invention under PCT Rule 13.2 is fulfilled only when (a) a special technical feature is shared among the inventions and (b) when such a technical feature defines a contribution over the prior art. Since the standard for restriction for applications filed under 35 USC 371 requires the examiner to establish a lack of a special technical feature under 35 USC 121 and 372, and to establish whether the technical feature defines a contribution over the prior art, and because the examiner failed to satisfied both conditions, the examiner has not met the burden to require restriction in this application.

In view of the above discussion, the petition is **GRANTED**.

The application will be forwarded to the examiner for examination of all of the claims present in the application, namely, Claims 18-23.

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